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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/255,107	02/22/1999	ROBERT B HARKNESS	2747-51635/K	8000

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EXAMINER

LOCKER, HOWARD J

ART UNIT

PAPER NUMBER

1661

DATE MAILED: 12/27/2001

12

Please find below and/or attached an Office communication concerning this application or proceeding.


**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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EXAMINER

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DATE MAILED:

 This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS
OFFICE ACTION SUMMARY
☒ Responsive to communication(s) filed on October 01, 2001
☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

 A shortened statutory period for response to this action is set to expire Three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).
Disposition of Claims
☒ The claim is is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ The claim is is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.
Application Papers
☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.
Priority under 35 U.S.C. § 119
☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
Attachment(s)
☒ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

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- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

The claim is rejected under 35 U.S.C. § 102 (b) as the instant plant 'Haryup' was described in the following printed publications more than one year prior to the date of application for plant patent (February 22, 1999) in the United States:

NZ PBR ROS511 (filed on November 03, 1994, with application and denomination published on January 14, 1995), **which matured into Grant/Reg. Number 1131** on August 15, 1996 (published October 14, 1996); GB PBR 00501357 (filed on October 23, 1991), **which matured into Grant/Reg. Number 5467** on December 20, 1993 (published on January 01, 1994).

Applicant's acknowledgement as to the correctness of the above information is noted, as is the admission/stipulation "***that the rose variety of the subject application was placed on public sale in United Kingdom in November, 1992.***" (emphasis added), as set forth at page 2 of applicant's October 01, 2001 response.

Applicant's statement that the plant of the subject application was not sold or on sale in the United States more than one year before the filing date of the subject application is likewise noted.

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A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the printed publication, combined with knowledge in the prior art, would have enabled one of ordinary skill in the art to reproduce the claimed plant, and said printed publication was published more than one year prior to the date of application in the United States (*In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could have reproduced the plant from a publicly available source, then the publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ 2d, 1618, 1620, (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokora was on public use or sale in the United States but, rather, whether Siokora seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokora cultivar disclosed in the cited publications."). See also MPEP section 2121.03.

It has been conceded by applicant and determined that the above publicly available publications disclose the claimed plant variety and that the claimed variety was offered for sale more than one year prior to the filing date of the subject application for United States Plant Patent.

As such, the published applications, published/accepted denominations (if any) or the resulting grants (so long as they are more than one year prior to the filing date of the subject application for United States Plant Patent) combined with the knowledge in the prior art, would have enabled one of ordinary skill in the art to reproduce the claimed plant.

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Information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art. A publication relied upon as prior art under 35 U.S.C. 102(b) must be enabling. The text of the relied upon publications standing alone would not have enabled one skilled in the art to practice the claimed invention. When a claim is drawn to a plant, the reference, combined with knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the plant. The admission of prior offer for sale more than one year prior to the filing date of the instant application enables the referenced documents because the disclosed cultivar could have been propagated from publicly available materials, and one skilled in the art would have the knowledge of how to do so, given the notoriety of various methods of asexual propagation. See, e.g. *Thomson* supra. See also Cooper, Biotechnology and the Law, section 8.05 (1998 Clark Boardman Callaghan). "In essence then, a plant patent applicant cannot lose his rights through public description of the new variety so long as he does not make the stock available for propagation by the public".

With respect to applicant's contention that the court in *LeGrice* knew that the plant was on sale, such is not borne out by the record. The Board of Appeals felt that the publication alone was enough to sustain the rejection of the examiner, and as such did not consider the issue of whether or not the plant was on sale to be relevant. The CCPA limited their review solely to the question of whether the publication alone was enabling, and the Board in *Thomson* felt that there was no evidence of sale in *LeGrice* (5th paragraph from the end of *Thomson*).

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The contention that foreign commercial or public use is not a bar to patentability under 35 U.S.C. 102(b) is noted but is not relevant. The clear wording of 35 U.S.C. 102(b) is "A person shall be entitled to a patent unless - ... (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or sale in this country, more than one year prior to the date of the application for patent in the United States..." There is no restriction of the bar under 35 U.S.C. 102(b) to printed publications in this country. That is, the statute explicitly extends the scope of the bar from printed publications to this or a foreign country. There is no requirement that a printed publication that describes the invention be printed or enabled in this country. The second clause of 35 U.S.C. 102(b) barring public sale or use in this country is not relevant because a rejection under 35 U.S.C. 102(b) over the foreign published documents, as enabled by the admitted availability of the plants outside the U.S. more than one year prior to the date of domestic filing, is not over public use or sale, but on a printed publication.

The argument that the claimed plant was not available in the United States more than one year prior to domestic filing is not persuasive, as applicant is attempting to create a geographic component of enablement, which does not exist in statute or in case law. For a patent specification to be enabling, there is no requirement that the starting material required to produce the claimed invention must be located in the United States. See, for example, *Ex Parte Rinehart* (10 USPQ2d 1710), where a specification was found to be enabling even though the required biological material was only available in the ocean off the coast of Central and South America. Even if there were a requirement that the plant be available in the United States, applicant has not explained why the skilled rose grower could not have purchased the claimed plant and arranged for its importation into the United States through the usual channels (customs and USDA quarantine).

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Applicant then argues that the plant in *In re LeGrice* was available only in a foreign country and that the fact situation there is the same as in the instant application. This argument is not persuasive because in *LeGrice*, applicant never admitted that the rose cultivar was on sale anywhere. Instead applicant stated, "Prior public use or sale are the avenues by which a plant enters the public domain" (*LeGrice*, page 372). The court then added "section 102(b) requires that an inventor, who has placed his invention in the public domain, file his application within one year thereafter" (page 372).

Applicant's contention that the Court knew that the claimed plant had been on sale and found that fact irrelevant is contrary to the written opinion cited above. The *LeGrice* decision repeatedly returns to the question of whether the invention was "in the possession of the public". Clearly, if an invention is on sale to the public, then the public must have possession of it. As stated by the Board of Appeals and Interferences in *Ex Parte Thomson*, "the court's holding was based on the specific 'printed publications' before it, and no indication was given that the 'prior catalogue publication' before it evidenced commercial availability in a readily enabling form" (p. 1622).

Applicant then argues that the examiner should not rely upon *Ex Parte Thomson* as this decision is contrary to law. This argument is not persuasive as *Thomson* has not in fact been overturned as of this time to the best of the examiner's knowledge. The question in *Thomson* as in *LeGrice* was "what is required to "enable" a printed publication describing a plant? Except for the type of patent sought, the instant application presents the same fact pattern as in the *Thomson* case. The printed publications cited in *Thomson* were not enabled by applicant's deposit of seeds, but by the commercial availability of the seeds outside the U.S. As stated in *Thomson*, "we are convinced that the skilled cotton grower would have had the wherewithal, upon reading the publicly disseminated reference articles, to purchase the commercial available Siokora seeds, and employ conventional

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techniques to plant and nurture the seeds to maturity in order to obtain the claimed invention, i.e., Siokora plants, seeds and pollen. It is reasonable to conclude that, at the time the cited articles were published, skilled artisans throughout the world would have found Siokora seeds readily available on the open market."

Public notice of a Plant Breeder's Right application informs the public of the existence of the plant. Sale or other public use of said plant then puts it in the public's possession. If a plant is in the public's possession, then a printed publication can be a statutory bar. The following is a passage from LeGrice, page 379:

The mere description of the plant is not necessarily an "enabling" disclosure. Such descriptions, just as in the case of other types of inventions, in order to bar the issuance of a patent, must be capable, when taken in conjunction with the knowledge of those skilled in the art to which they pertain, of placing the invention in the possession of those so skilled.

The sale or use of the plant in the public domain and the knowledge in a printed application would enable a person skilled in the art to reproduce the plant, thus the publication is a statutory bar under 35 U.S.C. 102(b).

Arguments raised relative to the propriety of use of a combination of events in an effort to anticipate an invention under 35 U.S.C. 102(b) have been addressed in the above rejection, which sets forth the rationale. The rejection is not based on a combination, but over the publication alone. Foreign commercial availability is simply evidence supporting the enabling nature of the publication.

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Arguments brought forth relative to substantive departure from prior practice within the art have been considered but are not persuasive. The only change in policy is in the use of rule 1.105, which was published in the Federal Register in the PBG advance notice, notice of proposed rulemaking and final rule. The substantive policy is the implementation of the existing 35 U.S.C. 102(b) to a given factual pattern. The factual pattern is analogous to the opinion in *Ex Parte Thomson*, which demonstrates the strength of 35 U.S.C. 102(b) under such circumstances. The USPTO cannot ignore 35 U.S.C. 102(b) just because of the recognition of a recurring factual pattern that runs counter to that paragraph where it may not have been recognized before.

The balance of the arguments brought forth in applicant's October 01, 2001 response have been considered, but are accorded little weight as they are not germane to the 35 U.S.C. 102(b) issues set forth above

2. The information provided by applicant relative to the requirement for information under 37 CFR 1.105 as set forth in the Office action mailed August 03, 2001 is deemed sufficient.

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3. Applicant is advised of the changes to 37 CFR 1.84 which took effect November 29, 2000 and apply to any applications (and to new drawings filed in previously existing applications) filed thereafter. In particular, 37 CFR 1.84(e) now states, in part:

Photographs must be developed on paper meeting the sheet size requirements of paragraph (f) of this section and margin requirements of paragraph (g) of this section.

The USPTO no longer accepts photographs mounted on Bristol board, paper or other material. Further information on the new rules is available on the USPTO web site at www.uspto.gov.

4. Applicant is advised of the new procedures for amending the specification and claim under 37 CFR 1.121. The new procedures are optional until February 28, 2001 and **mandatory** beginning March 01, 2001. Information on the new procedures is available on the internet at <http://www.uspto.gov/web/offices/dcom/olia/pbg/index.html>.

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5. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 703-308-2924, and whose normal work hours are Monday through Thursday, from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Bruce Campell, can be reached at 703-308-4205.


Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

TELECOPY/FACSIMILE TRANSMISSION

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to this Group via the PTO Fax Center in Crystal Mall 1 (CM 1). The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM 1 Fax Center number is 703-308-4556 or 703-305-3592.

Howard J. Locker/hjl

December 18, 2001


HOWARD J. LOCKER
EXAMINER
GROUP ART UNIT 1661

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